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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,829	01/11/2001	Koichiro Yamaguchi	NAK1-BN62	8528

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EXAMINER

BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/758,829	<b>Applicant(s)</b> YAMAGUCHI ET AL.	
	<b>Examiner</b> KIEU-OANH T. BUI	<b>Art Unit</b> 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 2-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

3. Claims 1, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (U.S. Patent No. 5,734,853) in view of Durden et al (US Patent 5,003,384).

Regarding claim 1, Hendricks discloses “a digital broadcast receiving device that receives a broadcast wave including interactive data to achieve pseudo-interactive communications, the interactive data being repeatedly broadcasted”, i.e., a digital set top terminal receives broadcasting signals for interactive communications between the set top terminal and the broadcasting source via a cable headend (Figs. 1-3, and col. 3/lines 20-55), the digital broadcast receiving device comprising: “receiving means for receiving the broadcast wave” (Fig. 5a for internal structure of the set top receiving device, and tuner 603 for receiving cableTV input and modem 627 for communications between the set top terminal and the cable headend, see col. 19/lines 7-42); “judging means for judging a state that is established during the reception of the broadcast wave based on first information, the state being one of a preview state, a prohibited

Art Unit: 2611

state, and a permitted state, wherein the first information shows conditions for using the received broadcast wave under a subscription contract, wherein in the preview state, the received broadcast wave is permitted to be used regardless of the subscription contract being made, and wherein in the prohibited state, the broadcast wave is prohibited from being used because the subscription contract is not made; and restricting means for restricting use of the interactive data when either the preview state or the prohibited state is judged as being established", i.e., all of the judging means to determine whether a user is a subscriber or not, namely, the subscription contract is being made or not, so that the system can either grant the access or deny the access and even limit the access as described in diagrams in Figures 12a-12f, col. 29/line 49 to col. 32/line 18; and Fig. 17 clearly shows that the viewer can preview a program, at this time, the viewer is just browsing through a list of hit movies as shown in Fig. 16 and as he chooses Terminator 4, he has a chance to preview the program regardless of the subscription contract being made or not, as soon as he pays the charge for the program, a "Thank you" screen is displaying and he can join in and enjoy the movie as shown in Fig. 18, and col. 35/line 37 to col. 36/line 29; the system limits or restricts the user's access if the subscription contract is not being made, and the program list is redisplaying to the user again (col. 28/lines 41-52).

Hendricks does not further includes the step of having "a restricting unit for restricting the use of the interactive data when the preview state is judged as established, regardless of a subscription contract being made, or the prohibited state being judged as established" as amended; however, the technique of controlling the preview session regardless of the subscription made is known in the art. In fact, Durden teaches a same technique as the system controls the preview time before the user subscribes for the service from 0 min to 14 minutes for

Art Unit: 2611

preview, and the system can control whether to grant or terminate the preview state to the viewer (col. 6/lines 22-33 and col. 10/lines 20-68). Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' preview state with Durden's teaching technique of controlling the preview free time regardless whether the viewer is subscribed or not.

Regarding claim 14, Hendricks discloses "a digital broadcast system, comprising: a digital broadcast sending device that broadcasts a broadcast wave containing interactive data, the interactive data being repeatedly broadcasted; and a digital broadcast receiving device that receives the broadcast wave to achieve pseudo-interactive communications, the interactive data being repeatedly broadcasted, wherein the digital broadcast receiving device includes: receiving means for receiving the broadcast wave; judging means for judging a state that is established during the reception of the broadcast wave based on first information, the state being one of a preview state, a prohibited state, and a permitted state, wherein the first information shows conditions for using the received broadcast wave under a subscription contract, wherein in the preview state, the received broadcast wave is permitted to be used regardless of the subscription contract being made, and wherein in the prohibited state, the broadcast wave is prohibited from being used because the subscription contract is not made; and restricting means for restricting use of the interactive data when either the preview state or the prohibited state is judged as being established", i.e., a digital set top terminal receives broadcasting signals for interactive communications between the set top terminal and the broadcasting source via a cable headend (Figs. 1-3, and col. 3/lines 20-55); Fig. 5a for internal structure of the set top receiving device, and tuner 603 for receiving cableTV input and modem 627 for communications between the set top terminal and the cable headend, see col. 19/lines 7-42; and all of the judging means to

Art Unit: 2611

determine whether a user is a subscriber or not, namely, the subscription contract is being made or not, so that the system can either grant the access or deny the access and even limit the access as described in diagrams in Figures 12a-12f, col. 29/line 49 to col. 32/line 18; and Fig. 17 clearly shows that the viewer can preview a program, at this time, the viewer is just browsing through a list of hit movies as shown in Fig. 16 and as he chooses Terminator 4, he has a chance to preview the program regardless of the subscription contract being made or not, as soon as he pays the charge for the program, a "Thank you" screen is displaying and he can join in and enjoy the movie as shown in Fig. 18, and col. 35/line 37 to col. 36/line 29; the system limits or restricts the user's access if the subscription contract is not being made, and the program list is redisplaying to the user again (col. 28/lines 41-52).

Hendricks does not further includes the step of having "a restricting unit for restricting the use of the interactive data when the preview state is judged as established, regardless of a subscription contract being made, or the prohibited state being judged as established" as amended; however, the technique of controlling the preview session regardless of the subscription made is known in the art. In fact, Durden teaches a same technique as the system controls the preview time before the user subscribes for the service from 0 min to 14 minutes for preview, and the system can control whether to grant or terminate the preview state to the viewer (col. 6/lines 22-33 and col. 10/lines 20-68). Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' preview state with Durden's teaching technique of controlling the preview free time regardless whether the viewer is subscribed or not.

As for claims 15-16, these claims for "a receiving method used by a digital broadcast receiving device" and "a computer-readable recording medium storing a program used by a

Art Unit: 2611

digital broadcast receiving device” with same limitations as disclosed earlier are rejected for the reasons given in the scope of claim 1 in view of Hendricks and Durden as explained in details above.

*Allowable Subject Matter*

4. Claims 2-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter:

As for claim 2, (after carefully reviewed Hendricks), Hendricks and Durden do not further discloses the judging unit which includes an obtaining subunit, a contract judging subunit for judging whether a subscription contract has made or not by comparison of two pieces of information, one stored in a recording medium and one information shows conditions for using the broadcast wave, and “a preview state judging subunit for (a) judging whether a predetermined period has passed since a start of the reception of the broadcast wave if the contract judging means determines that the subscription contract is made, “(b) determining that the preview state is established during the reception on judging that the predetermined period has not passed”, and “(c) determining that the prohibited state is established during the reception on judging that the predetermined period has already passed” because the preview judging subunit is determined based on the status condition of the contract judging subunit, the predetermined period has passed or not during the reception of the preview state, and the predetermined period has passed or not for the determination of the prohibited state. Claims 3-13 are allowable based on the dependency of claim 2.

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ohkura et al (US patent 6,347,400 b1), Sciammarella et al (US Patent 6,425,129 B1), and Chimoto (US Patent 6,532,590 B1) disclose electronic program guides with previews.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Art Unit: 2611

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to PTO New Central Fax number:**

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kieu-Oanh Bui  
Primary Examiner  
Art Unit 2611

KB  
August 9, 2005